

REMARKS

In a Final Office Action mailed on September 4, 2003, the Examiner contended the Information Disclosure Statement previously filed by Applicants lacked a statement and fee and therefore was not considered; claims 1-8 and 18 were rejected under 35 U.S.C. § 102(e) as being anticipated by Tarlton; claims 1-8 and 10-22 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kilgore; claims 1-8, 10-12, 18 and 20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Moss; and claims 23 and 24 were objected to as being dependent upon a rejected base claim but allowable if rewritten in independent form. These points are addressed below.

Information Disclosure Statement

In the Final Office Action, the Examiner contends that the Information Disclosure Statement was allegedly filed on March 17, 2003, a date on which the first office action was mailed, and thus, fails to comply with 37 CFR 1.97(d). However, Applicant submits that the March 17, 2003, date is the date that the Information Disclosure Statement was received by the Patent Office, not the date on which the Information Disclosure Statement was filed.

Attached hereto as Exhibit A are copies of the papers filed with the Information Disclosure Statement on March 12, 2003, a date that precedes the March 17, 2003, mailing date of the first office action. The rules state that an Information Disclosure Statement shall be considered by the Office if filed before the mailing of a first action on the merits. 37 CFR 1.97(b)(3). Because Applicants complied with this provision, the Examiner is requested to consider the references submitted on the Information Disclosure Statement, as no fee or statement was required from the Applicant.

Rejections of Claims 1-8:

The system of claim 1 includes a well and a carousel of tools that is sealed within the well to automatically and selectively deploy the tools in the well. At least one of these tools is adapted to deploy sensors at a predetermined depth.

Claim 1 stands rejected under 35 U.S.C. § 102 in view of Tarlton. In the latest Office Action, the Examiner contends that, "the pipeline of Tarlton having the carousel is in sealing

engagement with the well and thus considered to be sealed within." Final Office Action, 4. However, Applicants cannot find where Tarlton even mentions a well. Therefore, considering all limitations of claim 1, Tarlton does not teach the well of claim 1, and as a consequence, Tarlton cannot teach a carousel of tools that is sealed within a well. Thus, when all limitations of claim 1 are given the patentable weight that they are due, claim 1 overcomes the § 102 rejection in view of Tarlton.

Claim 1 is also rejected under 35 U.S.C. § 102 in view of either Kilgore or Moss. The Examiner contends, "the claim language 'adapted to' amounts to intended use and; therefore, the tools that deploy sensors at a predetermined height is not positively claimed and thus not required to be shown or disclosed by the reference in order to make the rejection." Final Office Action, 4. However, the Examiner is improperly ignoring claim limitations (i.e., the limitations following the "adapted to" language) that distinguish claim 1 from Kilgore and Moss. Contrary to the Examiner's position, courts have approved the use of 'adapted to' as providing structural limitations. See *In re Venezia*, 189 U.S.P.Q. 149, 151-52 (CCPA 1976) ("rather than being a mere direction of activities to take place in the future this language ["adapted to"] imparts a structural limitation..."). In this manner, the court in *In re Venezia* stated that there is "nothing wrong in defining the structures of the components... in terms of the interrelationship of the components." *Id.* at 152. It is noted that the Federal Circuit has also explicitly approved the language "adapted to." For example, in *Pac-tec, Inc. v. Amerace Corp.*, 14 U.S.P.Q.2d. 1871, 1876 (Fed. Cir. 1990), Pac-tec asserted that claims were invalid because the phrase "adapted to" did not add structural limitations. However, the Federal Circuit labeled as "frivolous" Pac-tec's assertions that the "adapted to" language was improper. *Id.* at 1876.

Thus, when all limitations of claim 1 are given the patentable weight that they are due, neither Moss nor Kilgore teaches or even suggests at least one tool that is adapted to deploy sensors at a predetermined depth. Therefore, for at least this reason, claim 1 overcomes the § 102 rejections in view of Moss and Kilgore.

Claims 2-8 are patentable for at least the reason that these claims depend from an allowable claim.

Rejections of Claims 10-12:

Claim 10 is rejected under 35 U.S.C. § 102 in view of either Kilgore or Moss. The Examiner contends, "the method of dropping tool into a subsea well in which the step of halting flow is inherent since the tools would not freefall otherwise and no flow is shown, thus the flow must have already been halted." Final Office Action, 5. However, for a claim limitation to be inherent in a cited reference, the limitation must *necessarily flow* from the cited reference. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). This is not the case here, as there are clearly alternatives that may be used to deploy a tool in a well. For example, for a minimal upward flow, a tool would still descend in a well under the force of gravity and thus, the requirement that the flow is halted is not necessary. As another alternative, a flow may be reverse circulated through a well to force a tool down through the well, and in this case, the flow would not be halted but rather the flow direction would be reversed. Therefore, because there are clear alternatives to halting the flow in a well to deploy a tool, the Examiner has not made a showing why the missing claim limitation necessarily flows from the cited reference. Thus, for at least the reason that neither Kilgore nor Moss explicitly, implicitly or inherently teaches or even suggests halting the flow of fluid in a well for purposes of deploying a tool, these references do not anticipate claim 10.

Claims 11 and 12 are patentable for at least the reason that these claims depend from an allowable claim.

Rejections of Claims 13-17:

Claim 13 is rejected under 35 U.S.C. § 102 in view of Kilgore. The Examiner contends, "Kilgore specifically discloses examples of tool that measure or sense and environmental property (col. 1, lines 20-30)." Final Office Action, 5. Although the Examiner contends that Kilgore specifically discloses such examples, Applicant cannot find where in the cited language Kilgore teaches or suggests using sensors to measure at least one environmental property of a well. More specifically, the language cited by the Examiner from Kilgore is reproduced below:

Typical problems requiring correction within a well are: crushed regions in the tubing; sand bridges or accumulation of paraffin, scale, rust or other debris. Maintenance procedures that must also be accomplished from the surface include the need to set or remove lock mandrels, collar stops or safety valves. Specific, commercially-available tools have been developed for each of these maintenance actions or problems solutions.

Kilgore, 1:20-27. As can be seen from the cited language, the cited language discusses tools that have been developed for maintenance actions or problem solutions. However, this language does not disclose a sensor to measure at least one environmental property of a well. Rather, the cited passage merely mentions tools to solve well problems that have already been detected.

Thus, for at least the reason that Kilgore fails to teach or even suggest using sensors to measure at least one environmental property of a well, withdrawal of the § 102 rejection of claim 13 is requested. Claims 14-17 are patentable for at least the reason that these claims depend from an allowable claim.

Rejections of Claims 18-22:

Claim 18 is rejected under 35 U.S.C. § 102 in view of either Tarlton, Kilgore or Moss. In the latest Office Action, the Examiner contends, "each of the tools discussed in Moss, Kilgore and Tarlton can be considered a robot." Final Office Action, 5. However, the Examiner fails to provide any support for this reasoning and does not show, by way of example, why any particular tool allegedly discloses the robot of claim 18.

The Examiner cannot be unreasonable in construing a claim limitation, as an arbitrary definition cannot be applied to a claim limitation. Rather, the interpretation of a particular claim term must be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); *see* M.P.E.P. § 2111. The Federal Circuit has held that "dictionaries, encyclopedias and treatises, publicly available at the time the patent is issued, are objective resources that serve as reliable sources of information on the established meanings that would have been attributed to the terms of the claims by those of skill in the art." *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 64 U.S.P.Q.2d 1812, 1818 (Fed. Cir. 2002).

Thus, turning to FOLDLOC, an online dictionary, the term "robot" is defined as "a mechanical device for performing a task which might otherwise be done by a human" (*see* Exhibit B). This construction of "robot" is consistent with the specification. *See Markman v. Westview Instruments, Inc.*, 34 USPQ2d 1321, 1329-30 (Fed. Cir. 1995) (holding claim terms are to be interpreted in view of the specification). In this manner, the specification describes a

tractor 150 (a possible embodiment of a "robot") that may perform tasks that might otherwise be done by a human, such as (by way of example) tasks that involve physically moving tools within a well and physically operate a sleeve on a valve. See specification, p. 10, ll. 30 and p. 11, 1-10. Thus, without the tractor 150, a human may need to insert a tubing down into the well for purposes of performing one or more of these functions. Of course, the tractor 150 may perform other and/or different functions in other embodiments of the invention. Furthermore, in other embodiments of the invention, the robot may not take on the form of a tractor.

Thus, when "robot" is assigned a reasonable construction by the Examiner, claim 18 overcomes the § 102 rejections, as none of these references disclose such a robot.

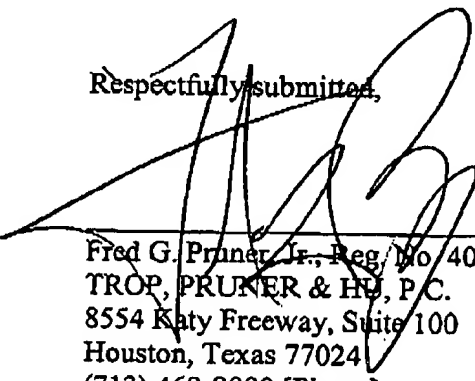
Claims 19-22 are patentable for at least the reason that these claims depend from an allowable claim.

CONCLUSION

In view of the foregoing, consideration of the previously-filed Information Disclosure Statement, withdrawal of the §§ 102 and 103 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (22.1410).

Respectfully submitted,

Date: September 24, 2003


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